

REMARKS

In the Office Action, the Examiner rejected Claims 1-45, which are all of the pending claims, under 35 U.S.C. 103 as being unpatentable over the prior art. Specifically, Claims 1-5, 10-20, 25-35 and 40-45 were rejected as being unpatentable over U.S. Patent 6,073,138 (de l'Etraz, et al.) in view of U.S. Patent 6,148,342 (Ho); and Claims 6-9, 21-24 and 36-39 were rejected as being unpatentable over de l'Etraz, et al. in view of Ho and U.S. Patent 6,014,634 (Scroggie, et al.).

The Examiner also objected to the language used in Claims 1, 16, 31, 35, 36 and 45. Independent Claims 16 and 31, and the claims dependent therefrom, were further rejected under 35 U.S.C. 101 as directed to non-statutory subject matter.

It is noted that the previous rejection of the independent Claims 1, 16 and 31 are being fully anticipated by de l'Etraz, et al. has been withdrawn.

Independent Claims 1, 16 and 31 are being amended to better define the subject matters of these claims, and, in particular, to describe more specifically, the function and operation of the logical link between the public and private data records.

Also, Applicants respectfully traverse the rejection of Claims 16-45 under 35 U.S.C. 101 and the objection to the language of Claims 1, 16, 31, 35, 36 and 45.

In rejecting Claims 16-45 under 35 U.S.C. 101, the Examiner argued that Claims 16 and 31 do not list any hardware (i.e. computer) tied to the steps in order to operate the steps of the claims therefore resulting in software only implementation.

Claim 16, however, does expressly set forth hardware. Specifically, the claim lists a separator, a logical link creator and a receiver. These are all physical elements of a system. In the preferred implementation of the present invention, these elements are a computer that is programmed and operated in a certain way, and they are actual, real physical elements.

It is noted that the word “computer” is not in Claim 16. However, there is no requirement in or under 35 U.S.C. 101 that the word “computer” appear in a system claim. Claim 16 sets forth real, physical elements and Claim 16 and the claims 17-30, which are dependent from Claim 16, are directed to subject matter within the meaning of 35 U.S.C. 101.

Claim 31 is directed to an article of manufacture. The invention defined by Claim 31 is not computer code per se, but instead is an article of manufacture having computer readable program code. Claim 31 is not a data structure or a computer listing per se, but is directed to a computer readable media – a tangible, real article of manufacture – that is tangibly embodied with computer readable program code for performing specific function. Thus, Claim 31 and Claims 32-45, which are dependent from Claim 31, are directed to statutory subject matter.

In the Office Action, the Examiner argued that the specification does not support the claim language of ”computer readable medium.” It is noted, that paragraph 49 of the specification expressly indicates that the invention can be included in an article of manufacture having, for instance, “computer usable media.” This paragraph goes no describe this media as having embodied therein “computer readable program code means.” This indicates that the invention can be embodied in a computer usable media that is readable by the computer, or “computer readable medium.”

For the foregoing reasons, the Examiner is respectfully requested to reconsider and to withdraw the rejection of Claims 16-45 under 35 U.S.C. 101.

With respect to Claims 1, 16, 31, 35, 36 and 45, the Examiner objected to the use of the word “for” in the claims. This objection is respectfully traversed

The language that follows the word “for” describes the function performed by elements of the claims. For example, Claim 16 describes “computer readable program code for separating a data record into a public data record stored in a public data set and a private data record stored in a private data set. The functional language after the word “for” does not describe merely a desired result, but instead describes the required operation of this computer readable program code. Accordingly, this functional language carries patentable weight.

Likewise, the functional language in Claims 31, 35, 36 and 45 describe the required operations of various elements, and these elements, when operated, must be operated in these ways in order for a particular computer program product to come within the scope of these claims.

Applicants have a wide discretion as to how the invention is defined. The use of functional language, as used in the present claims, is appropriate, and the functional language is a positive limitation that describes how elements operate. Thus, this functional language carries patentable weight and needs to be taken into account when determining the patentability of the claims.

For the foregoing reasons, Applicants respectfully request that the Examiner reconsider and withdraw the above-discussed objection to Claims 16, 31, 35, 36 and 45.

Moreover, all of Claims 1-45 patentably distinguish over the prior art because the prior art does not disclose or suggest the logical link described in independent Claims 1, 16 and 31, and in particular, the use of a logical link, stored in the public data record, that provides access to

the private data record from the public data record, where that access enables use of the private data record without providing read access to the private data record.

de l'Etraz describes a system for proving relational patterns between entities, and in particular, provides a contact pathway that maps how to get to certain persons and organizations. This system includes a public information database containing data on the members of a plurality of entities in which a user has an interest in, and a private contact information database containing the personal contacts of the user. Software code is provided for accessing, in response to receiving a request from the user, the public and private databases, and this software code processes accessed information located in the databases in order to display a contact pathway.

One very important difference between the present invention and the procedure disclosed in de l'Etraz is the type of access the user has to the private data. With the present invention, the logical link, which links the public data record with the private data record, provides the user with use access but not read access to the private database. In contrast, in de l'Etraz the user not only has read access to the private database, the user is actually the one who provides the data to that private database.

The above-mentioned feature of the present invention is very important. As discussed in detail in the present application, the present invention enables users, such as merchants, to use data from the private database without actually having read access to that data, thus maintaining the confidentiality of that private data. There is no reason to maintain this confidentiality with the procedure disclosed in de l'Etraz because, as indicated above, in de l'Etraz, the user is the one who actually provides the data to the private database.

The present invention utilizes not just a logical link to the private data from the public data, but a specific type of logical link – one that provides the user with use access, but not read access, to the private data. This de l'Etraz does not show or suggest.

Ho, also does not disclose or suggest this feature. Ho relates to retrieving sensitive stored data. In the disclosed method, a receiving terminal receives a request for data from a user and encrypts an identifier with a first code and a data access request with a second code. The identifier and data access request are transmitted to a first database that decodes the identifier and determines whether the user has authorization to request the desired information.

Thus, with Ho, the user may or may not have access. With the present invention, a key feature is not whether the user has or does not have access, but the type of access the user is given – access to use the data but not to read the data.

The other references of record have been reviewed and these other references, whether considered individually or in combination, also do not disclose or suggest this feature of the present invention.

Scroggie, et al. was cited for its disclosure of using certain information including a network address, and transmitting a message to that address. This reference does not disclose or suggest, though, accessing and using private data, in the manner described above, without giving the user/requestor read access to the private database.

Independent Claims 1, 16 and 31 are being amended to emphasize differences between the claims and the prior art. Specifically, each of these claims is being amended to describe expressly that the logical link between the private and public data records, and which is stored in the public data record, enables the user to use the private data without providing read access to that data.

Because of the above-discussed differences between Claims 1, 16 and 31 and the prior art, and because of the advantages associated with those differences, these claims 1, 16 and 31 patentably distinguish over the prior art. Claims 2-15 are dependent from, and are allowable with, Claim 1, and Claims 17-29 are dependent from Claim 16 and are allowable therewith. Likewise, Claims 32-45 are dependent from, and are allowable with, Claim 31. The Examiner is thus respectfully asked to reconsider and to withdraw the rejections of Claims 1-45 under 35 U.S.C. 103, and to allow these claims.

For the reasons set forth above, the Examiner is asked to reconsider and to withdraw the objection to the language of Claims 1, 16, 31, 35, 36 and 45, and the rejection of Claims 16-45 under 35 U.S.C. 101. The Examiner is further requested to reconsider and to withdraw the rejection of Claims 1-45 under 35 U.S.C. 103, and to allow Claims 1-45. If the Examiner believes that a telephone conference with Applicants' Attorneys would be advantageous to the disposition of this case, the Examiner is asked to telephone the undersigned.

Respectfully submitted,

John S. Sensny
John S. Sensny
Registration No. 28,757
Attorney for Applicants

Scully, Scott, Murphy & Presser, P.C.
400 Garden City Plaza – Suite 300
Garden City, New York 11530
(516) 742-4343

JSS:jy